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09/622-645

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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/622,645 | 09/08/00 | LOREI | 09/08/00199 |

HM12/1025

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EXAMINER

HIGEL, F

ART UNIT PAPER NUMBER

1626

DATE MAILED: 10/25/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 to 63 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 to 63 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1626

Receipt is acknowledged of the information disclosure statement filed November 11, 2000, which has been entered in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1626

Claims 1 to 27 provide for the use of an organic compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1 to 27 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 1 to 62 are rejected under 35 USC 112, second paragraph, for failing to properly define the invention. The plural form "derivatives" must be changed to the singular form A compound. The expressions "an organic compound comprising an aromatic ring", "comprising", "noted . . .", "a substituent . . . comprising . . . proton donor or acceptor function capable of establishing", "proton donor or acceptor function", "function", "a derivative of . . .", "characterized in that", "interacts with", "establishes", "proton donor or acceptor function", "non-functionalized linear chain", "comprises", "proton acceptor functions", "a possible", "comprises in addition", "it being possible", "to comprise a substituent", "bon", "capable of establishing", "comprises at least", "(compound noted . . .)", "Di-or trisubstituted derivatives" (should be A di-or trisubstituted triph~~o~~ne compound), "and/or", in claim 41 "and" should be or, "uses as an intermediate", "a hydrolyzable protective group", "a protected alcohol function",

Art Unit: 1626

"uses . . . as starting material", "attachment", "possible attachment", "is obtained by", "magnesian synthesis", "monohalegenation", "is such that", "obtained directly from" (how?), "is exposed to ylide precursors", "precursors",
" $\text{Ar}(\text{Me})_3 \rightarrow \text{x}^3 \text{H}_2 \text{C}-\text{Ar}-(\text{Me})_2 \rightarrow \text{P}_a \text{A}^1 -\text{H}_2 \text{C}-\text{Ar}-(\text{Me})_2 \rightarrow \text{P}_a -\text{H}_2 \text{C}-\text{Ar}-(\text{CH}_2 \text{Z})_2$ " (How?) "a compound of the secondary amine type", "bonds established by", "follows the conditions of Mitsunobu", "compounds" (should be a compound); their application as therapeutically active substances", "antiviral agents", "prevention of infections due to a retro virus, in particular HIV" (there are no known therapeutic substances which prevent HIV) and "as combination product . . . spaced out over time . . . therapy" render the claims indefinite by placing no definite limits or boundaries on the claims. The method of preparation claims recite no positive reaction steps.

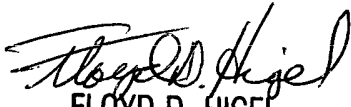
Coull et al and Fujita et al, cited, show the state of the art.

No claim is allowed.

Any inquiry concerning this communication should be directed to Floyd D. Higel at telephone number (703) 308-4530.

Higel:mv

October 23, 2001


FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT 123/626